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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/971,851	11/17/97	HORNBACK III	5324905A5A

IM61/0415
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EXAMINER
TRAN, H

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 04/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/971,851

Applicant(s)
Hornback, III et al

Examiner
Hien Tran

Group Art Unit
1764



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because the use of legal phraseology is improper (note "comprises" in line 3 and "comprising" in line 6). Correction is required. See MPEP § 608.01(b).

4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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Claim Rejections - 35 USC § 112

5. Claims 1-25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5 it is unclear as to which surface is implied and whether the surface is the same as to the top and bottom surfaces set forth in line 4. See the remaining claims likewise.

In claim 11, line 1 "claims" should be changed to --claim--.

In claim 23, line 1 "the monolith" lacks positive antecedent basis and it is unclear as to how it is related to other elements of the system.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 7-19, 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 61-89916.

JP 61-89916 discloses a mounting article and a method of making a mounting article comprising:

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providing a sheet material 1 having a major top and bottom surfaces, a thickness, a length, a width and having a plurality of score lines in the top and bottom surfaces of the sheet material 1.

With respect to claims 2-5, 7-8, 14-15, 17, JP 61-89916 discloses that the score lines are disposed across the length or width of the sheet material 1 (see Fig. 1).

With respect to claims 10, 16, Fig. 1 of JP 61-89916 shows that the depth of the score line appears to be within the range of 5-90% of the thickness of the sheet material 1.

With respect to claims 11, 19, JP 61-89916 discloses that the sheet material 1 is ceramic fiber.

With respect to claims 12, 13, 18, JP 61-89916 discloses the pollution device comprising a housing 3 containing a pollution control element 2 and said mounting article 1 disposed between the housing 3 and the pollution control element 2.

With respect to claims 24-25, JP 61-89916 discloses that the sheet material has at least one score line in the both top and bottom surfaces.

Instant claims 1-5, 7-19, 21-25 structurally read on the apparatus of JP 61-89916.

8. Claims 1-4, 6, 9, 11-14, 17-19, 21-22, 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2-61313.

JP 2-61313 discloses a mounting article and a method of making a mounting article comprising:

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providing a sheet material 5 having a major top and bottom surfaces, a thickness, a length, a width and having a plurality of score lines 11 in the top and bottom surfaces of the sheet material 5.

With respect to claims 2-4, 6, 14, 17-18, JP 2-61313 discloses that the score lines are disposed across the length or width of the sheet material and have length of less than the length of the sheet material (see Fig. 2).

With respect to claims 11, 19, JP 2-61313 discloses that the sheet material is vermiculite.

With respect to claims 12-13, JP 2-61313 discloses the pollution device comprising a housing containing a pollution control element 1 and said mounting article 5 disposed between the housing and the pollution control element 1.

With respect to claim 24, JP 2-61313 discloses that the sheet material has at least one score line in the bottom surface facing the pollution control element 1 (see Fig. 2).

Instant claims 1-4, 6, 9, 11-14, 17-19, 21-22, 24-25 structurally read on the apparatus of JP 2-61313.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

11. Claims 6, 10-11, 16, 19-20, 23 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 61-89916 in view of JP 2-61313.

With respect to claims 6, JP 2-61313 discloses that the score line has a length that is less than the length of the sheet material.

It would have been obvious to one having ordinary skill in the art to select an appropriate length of the sheet material, such as less than the length of the sheet material as taught by JP 2-61313 in the apparatus of JP 61-89916, as such is conventional in the art and no cause for patentable here.

With respect to claims 10, 16, 20, the depth of the score line of JP 61-89916 appears to be within the range of 5-90% of the thickness of the sheet material and therefore it meets the claims. In any event, it would have been obvious to one having ordinary skill in the art to select an appropriate depth for the score line on the basis of its suitability for the intended use as a matter of obvious design choice, and since it has been held that where the general conditions of a claim are disclosed in the

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prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claims 11, 19, JP 61-89916 discloses that the sheet material comprises ceramic fiber. JP 2-61313 discloses that the sheet material comprises inorganic fiber, vermiculite, etc.

With respect to claim 23, JP 2-61313 discloses that the monolith has round shape.

12. Claims 5, 7-8, 10, 15-16, 20, 23 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 2-61313 in view of JP 61-89916.

With respect to claim 5, JP 61-89916 discloses that the score line extends across the entire length of the sheet material.

With respect to claim 7-8, 15, JP 61-89916 discloses that the score line extends across the length or width of the sheet material and therefore is perpendicular to the width and the length, respectively.

It would have been obvious to one having ordinary skill in the art to select an appropriate length and orientation for the score lines, such as the one taught by JP 61-89916 in the apparatus of JP 2-61313, on the basis of its suitability for the intended use as a matter of obvious design choice.

With respect to claims 10, 16, 20, the depth of the score line of JP 61-89916 appears to be within the range of 5-90% of the thickness of the sheet material and therefore it meets the claims. In any event, it would have been obvious to one having ordinary skill in the art to select an appropriate depth for the score line on the basis of its suitability for the intended use as a matter of obvious design choice, and since it has been held that where the general conditions of a claim are disclosed in the

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prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claim 23, JP 61-89916 discloses that both the top and the bottom surfaces of the sheet material have a plurality of score lines.

Conclusion

13. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1764.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (703) 308-4253. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenn Caldarola, can be reached on (703) 305-6118. The fax phone number for this Group is (703) 305-3599 (for Official papers after Final), (703) 305-5408 (for other Official papers) and (703) 305-6357 (for Unofficial papers).

When filing a FAX in Group 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to Glenn.Caldarola@uspto.gov. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35

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U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published in the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

HT
April 14, 1999

Hien Tran

**HIEN TRAN
PRIMARY EXAMINER
GROUP 1700**